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In re Application of MEIER et al
U.S. Application No.: 09/600,180
Int. Application No.: PCT/EP99/00635
Int. Filing Date: 01 February 1999
Priority Date: 05 February 1998
Attorney Docket No.: 194070US0 PCT
For: DEVICE FOR PRODUCING POLYMER
SUPPORT MATERIALS IN THE FORM OF
POROUS POLYMER BEADS

DECISION ON REQUEST
UNDER 37 CFR 1.497(d)

This is in response to applicant's "Request for Reconsideration of Decision on Request Under 37 CFR 1.497(a)" filed 30 March 2001, which is being treated as a renewed request under 37 CFR 1.497(d).

BACKGROUND

On 01 February 1999, applicants filed international application PCT/EP99/00635, which claimed priority of an earlier Germany application filed 05 February 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 12 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 05 August 2000.

On 04 August 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 21 December 2000, applicants filed a request under 37 CFR 1.497(d) accompanied by an executed declaration and an assignment document. The declaration is executed by the inventors identified in the international application as well as one additional inventor, i.e. Thomas Boller.

On 05 March 2001, the PCT Legal Office of the USPTO mailed a decision dismissing the 21 December 2000 request on grounds that written consent of the assignee had not been provided.

On 30 March 2001, applicants filed the present renewed request. The renewed request states that it is accompanied by an executed "Consent for Assignee to Change of Inventorship".

DISCUSSION

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

With regard to item (1) above, applicant has provided the requisite statement.

With regard to item (2) above, the requisite fee has been provided.

With regard to item (3) above, ownership of the application must be established when an assignee consents to a correction of inventorship. MPEP 324.

According to 37 CFR 3.73(b), ownership of the application may be established by: (A) submitting documentary evidence of a chain of title from the original owner to the assignee; or (B) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case, the assignment document filed 21 December 2000 sufficiently establishes a chain of title from the inventors to the assignee.

37 CFR 3.73(b) further provides that a submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. MPEP 324 states,

The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An officer (president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney from the inventors in an organization to a practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is empowered to sign the submission on behalf of the assignee.

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

In the present case, item (B) applies. Although the "Consent for Assignee to Change of Inventorship" filed with the renewed request states that Drs. Rainer Teubner and Michael Gottschalk are "duly authorized representatives of the Assignee for this application", the submission does not specifically set forth that Drs. Teubner and Gottschalk are empowered to sign the submission on behalf of the assignee. As applicants have not complied with any of items (A), (B), or (C) above, evidence of Dr. Teubner's and Dr. Gottschalk's authority to sign is required.

CONCLUSION

Because applicants have failed to satisfy item (3) above, the renewed request under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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